

REMARKS/ARGUMENTS

Status of the Application

Prior to entry of this amendment, claims 1-17 and 38-39 were pending in the application. An office action mailed November 29, 2005 rejected claims 1-3 and 38-39 under the second paragraph of 35 U.S.C. § 102(a) as being anticipated by ePAVE User Guide, published by U.S. Patent and Trademark Office on January 12, 2000 ("ePAVE"). The office action also rejected claims 4-8 and 11 under § 103(a) as being unpatentable over ePAVE, rejected claims 9 and 10 under § 103(a) as being unpatentable over ePAVE in view of USP 5,982,989 ("HSU"), rejected claims 12-14 under § 103(a) as being unpatentable over ePAVE in view of USP 6,182,078 ("Whitmyer"), and rejected claims 15-17 under § 103(a) as being unpatentable over ePAVE, in view of U.S. Patent Application Specification Authoring Guide for WordPerfect XML template, published by U.S. Patent and Trademark Office on December 14, 1999 ("XML Guide").

Claim Amendments

The applicants appreciate the Examiner's careful review of the claims, including the typographical error introduced by the prior amendment to claim 1. Claim 1 has been amended to correct this typographical error. It is believed that this amendment does not alter the scope of claim 1.

§ 102 Rejections

The office action rejected claims 1-3 and 38-39 under § 102(a), (b), etc. as being anticipated by ePAVE. This rejection is respectfully traversed, for at least the following reasons.

Consider, for example claim 1:

providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out;
actively prompting a user of the client computer to provide information corresponding to an invention into pre-selected fields of the smart electronic invention disclosure form;

receiving a filled-out invention disclosure in electronic form on the first server; and
automatically converting the invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server.

ePAVE teaches few, if any of the elements of claim 1. The ePAVE disclosure is directed toward a system for electronically filing a previously-prepared patent application or biosequence listing. *See, e.g.*, ePAVE at 39 (“The Attachments Tab allows you to attach your authored utility patent specification XML to your submission.”) In fact, ePAVE is an acronym for “an electronic Packaging and Validation Engine desktop software program.” *Id.* at 1. Hence, nothing in the ePAVE disclosure teaches or suggests that the ePAVE software package might be used to actually create an application – instead, the ePAVE software merely packages an already-created application for filing in the official USPTO format.

Hence, the ePAVE disclosure nowhere teaches or suggests “providing, from a first server computer to a client computer, an electronic invention disclosure form to be filled out.” The office action suggests that pages 1, 9, and 17-21 of ePAVE teach this element. A thorough review of those pages, however, reveals no such teaching, and if the rejection is maintained, the applicants respectfully request a more detailed explanation of what is regarded as the relevant teaching. For one thing, nothing in ePAVE teaches or suggests that ePAVE even provides an electronic invention disclosure form to be filled out. While ePAVE does teach that several fields (such as inventor, title of invention, etc.) can be filled out using the ePAVE software, the applicants respectfully submit that such fields fall far short of constituting an electronic invention disclosure form. For example, there is no teaching that the ePAVE software provides any facility for an inventor even to describe the nature of the invention.

Additionally, ePAVE teaches that the ePAVE software is installed locally on a client machine, so even if the ePAVE software could be considered as providing an electronic invention disclosure form (which, as noted above, it reasonably cannot), the ePAVE disclosure still fails to teach providing such a form “from a first server computer to a client computer,” as recited by claim 1. In fact, ePAVE specifically teaches that “[t]he ePAVE software is a client

application, and the current version must be installed on a local machine.” Accordingly, it is believed that the ePAVE disclosure fails to teach at least this element.

Likewise, the ePAVE disclosure fails to teach or suggest either “receiving a filled out invention disclosure form on a first server” or “automatically converting the invention disclosure form into a format of a patent application in response to a single click instruction input by the user on the first client and received by the server,” as recited by claim 1. Regarding the former element, the office action cites pages 29-31 and 49 of ePAVE as teaching the former element, and pages 18-19 and 28-29 as teaching the latter. Once again, a thorough review of those pages reveals no such teaching, and a more definite explanation of the relevant teaching is respectfully requested.

As noted above, the ePAVE disclosure specifically teaches that the ePAVE tool is designed to package a pre-prepared patent application for filing, so it is difficult to see how that disclosure could be read as either receiving a filled-out invention disclosure form or automatically converting such a form into a form of a patent application. A fortiori, ePAVE cannot be read as teaching such an automatic conversion in response to a single client instruction input by the user on the first client.” Moreover, as noted above, since “the current version [of ePAVE] must be installed on a local machine,” ePAVE fails to teach or suggest receiving either a filled-out invention disclosure form or a single click instruction input at a server computer.

For at least these reasons, ePAVE fails to teach or suggest each element of claim 1. For at least similar reasons, ePAVE fails to anticipate either claim 38 or claim 39, and claims 1, 38, and 39 therefore are believed to be allowable over ePAVE. Claims 2 and 3 are believed to be allowable at least by virtue of their dependence from claim 1. Consequently, reconsideration of the § 102 rejections is respectfully requested.

§ 103 Rejections

The office action rejected claims 4-8 and 11 under § 103(a) as being unpatentable over ePAVE, rejected claims 9 and 10 under § 103(a) as being unpatentable over ePAVE in view of Hsu, rejected claims 12-14 under § 103(a) as being unpatentable over ePAVE in view of Whitmyer, and rejected claims 15-17 as being unpatentable over ePAVE in view of XML Guide. These rejections are respectfully traversed.

As noted above, ePAVE fails to teach or suggest each element of claim 1. A review of Hsu, Whitmyer and XML Guide reveals no further disclosure that might remedy the missing teachings of ePAVE. Accordingly, since each of claims 4-17 ultimately depend from claim 1, they are believed to be allowable at least by virtue of that dependence. Reconsideration of the § 103 rejections is respectfully requested.

Request for Telephonic Interview

If the Examiner continues to believe that the claims are not allowable over the cited references, the undersigned respectfully requests a telephonic interview to discuss in more detail the failings of the cited references. The undersigned can be reached at 303-571-4000 to schedule the telephonic interview

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Conclusion

In view of the foregoing, the applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Respectfully submitted,



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Attachments

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